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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/915,691 07/25/2001 Amy E. Messner 10005172-1 7616

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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09/19/2007 PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/915,691

Applicant(s)

MESSNER ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 24-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This action is responsive to the papers filed 7/6/2007.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 24-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 26 each set forth system (apparatus) claims, yet they each positively include at least a "merchant" which is taken to represent a human being. See MPEP 2105.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 24-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1-3 are directed to a system (apparatus), yet the claims include what appear to be method steps.
- Claims 1-3, 24-33 are system (apparatus) claims, yet they include many features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system

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claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to* *<perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. Some examples:

- Claim 1, "a coupon service provider...to accept...to create" is unclear. Is this merely intended use? What structure is positively being claimed that is capable of accepting and creating? Applicant should claim a portion of the system apparatus which is programmed with the capability to accept parameters and the capability to create coupons with the accepted parameters.
- Claim 1, "may be transmitted", "to receive tender", "for determination", "to convey...and receive", each are unclear.
- Claim 2, "may be calculated" – it is unclear what structure is claimed which is programmed with such a capability(ies).
- Claim 26, coupon service provider "serving", "may be delivered", "generating coupon parameters", "may provide said generated coupon parameters", "may tender", "approval may be conveyed" – it is unclear what structure is claimed which is programmed with such a capability(ies).
- Claim 32 apparently claims the "structure" of an acknowledgement itself rather than the portion of the apparatus capable of generating and/or transmitting such acknowledgment – it is unclear what structure is claimed which is programmed with such a capability(ies).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Begum et al (5,420,606) in view of Fajkowski (5,905,246).

Regarding claims 1-3, 26, 33, Begum et al discloses a system for delivering and redeeming coupons wirelessly. Figure 1 is representative of the system, but note that systems controller (50) is described as being connected by an outside communications link (such as a modem) to a coupon redemption center so that editing, accounting and monitoring can be done remotely with a regional or national center where promotionals are solicited and created [col 3: lines 35-43]. The coupons of Begum et al are therefore taken to be created/generated at the remote coupon redemption center (which is not depicted in figure 1). The systems controller (50) communicates periodically with the coupon redemption center so that the coupon crediting and accounting can be accomplished remotely [5: 31-39]. It is not explicitly disclosed that the "regional or national network" is the Internet. However, Fajkowski discloses a similar system for delivering and redeeming electronic coupons which transmits the coupons over a public wide area network, such as the Internet, to a coupon card (smart card) and receives the redeemed coupons from a plurality of merchant computers (col 5, lines 15-17; col 6, lines 20-26; and col 29, lines 45-67). Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the invention as made to use a wide area network, such as the Internet, as the regional or national network in Begum. One of ordinary skill would recognize the Internet as a suitable and obvious alternative for the regional/national network link taught by Begum et al. Using the Internet for this required link would provide predictable success. One would have been motivated to use such an established wide area network in order to eliminate the need for the system owner to develop and field its own private regional or national wide area network, thus decreasing the cost to set up and run the system. The electronic coupons created and stored at the national center [3:42-43] possess parameters (such as pricing, product identity) are delivered via the national communications link (i.e. the obvious Internet link) to the store and wirelessly to a 2-way portable, wireless user device (14) [3:4-35]. In this manner, the coupon service provider is coupled to the Internet and a wireless network which is coupled to the user wireless device. The user can browse the coupons on the device and wirelessly tender them for redemption [2:18-30,4:43-63] which is taken to provide short range wireless communications [7:65-68]. The wireless counterpart at the POS redemption device is also taken to include an operable short-range wireless communication protocol. The POS device of Begum et al is capable of wirelessly receiving a tendered coupon and applying the discount when approved (a first validity); the transaction data is also delivered to the coupon redemption center [5:5-29]. The POS device of Begum et al is therefore coupled to the coupon redemption center by way of the obvious Internet link as described above. Begum et al speaks of the coupons being manufacturer or distributor coupons [5:35-36], but does not teach the merchant being capable of generating coupon parameters which are sent to the coupon

service provider for distribution. Merchant coupons however are well known and one of ordinary skill would find it obvious for merchants to be capable of creating coupons and their associated parameters at the national coupon redemption center via the national communications link in the manner provided for manufacturer's and their coupons. This would enable merchants to encourage consumers to shop at their stores through the offering of merchant coupons, especially where the merchant sells merchant-branded products (such as the merchant's generically-branded foods). Begum et al does not necessarily teach that coupon approval is sent from the host (coupon redemption center) to the POS to approve the discount. However Fajkowski discloses a similar system for delivering and redeeming electronic coupons which not only verifies the coupon data, but also discloses a fraud prevention method in which merchants can be placed on a suspend list so that "their coupons are no longer accepted for reimbursement" (col 3, lines 17-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to refer to a centrally managed "suspend list" in order to validate (a second validity) the merchant for each attempt at coupon validation so that coupons from invalid merchants are "no longer" accepted. One would have been motivated to provide validation from the coupon central host in order to reduce the amount of fraud as discussed by both Begum and Fajkowski.

Regarding the "plurality of merchants" mentioned in the claim 26, applicant has not positively required POS (or other) apparatus associated with plural merchants. The claims appear to set forth a single merchant's POS system. Nonetheless, Begum et al teaches that the POS transaction data sent to the remote host includes store

identification [5:24] which suggests that the system is designed to manage coupons and transaction data concerning a plurality of uniquely identified merchants. Further, it is well known for a central host to manage a collection of merchants within a franchise chain and it would have been obvious to one of ordinary skill at the time of the invention to have serviced such a plurality of merchants with the system of Begum et al/Fajkowski.

Regarding claims 24, 25, 27-30, Begum et al teaches the short-range wireless communications can be IR or RF [4:63-65], but does not teach the use of Bluetooth™. However, as applicant has pointed out Bluetooth™ is a well known and standardized short-range wireless technology and one of ordinary skill at the time of invention would have recognized that the alternative wireless communication could be accomplished with any well known protocol, including Bluetooth™, especially as it was commercially available at the time of the invention. Applicant in fact teaches that Bluetooth™ is not critical to the invention and the invention could be practiced with IR or RF [para 0011] or with standardized Bluetooth™ - in fact other (unnamed) technologies could also be used [para 0015].

Regarding claims 31, 32, Begum et al does not teach redemption approval acknowledgement sent to the wireless user device. However, Begum et al teaches that the user device may include messaging and prompting displayed to the user when coupons are available [6:17-31]. One of ordinary skill would find it obvious to also visually prompt the user not only about the status of newly discovered/available coupons as stated, but also as a confirmation for coupon redemption, in order to provide quality customer service and to avoid confusion whether tendered coupons are

accepted or not. Further when a tendered coupon is denied for some reason, it would have been obvious to one of ordinary skill at the time of the invention to have notified the user on his device of this fact, perhaps with an explanation.

Claims 1-3, 24-33 are alternative rejected under 35 U.S.C. 103(a) as being unpatentable over Begum et al (5,420,606) in view of Fajkowski (5,905,246) as described above and further in view of Jovicic et al (US5855007).

While Begum et al/Fajkowski collectively render obvious the concept of sending a coupon redemption validation (i.e. redeeming merchant validation) from a remote host to the POS, Jovicic et al also teaches e-coupons that are redeemed at the POS. During redemption, the coupon and transaction information is sent to the centralized and remote Internet coupon host to validate the coupon [3:34-38, 11:13-37]. It would have been obvious to one of ordinary skill at the time of the invention to have contacted the coupon host on a per-transaction basis so that coupon validation can be made by the central authority in order to validate the coupons and to prevent fraudulent redemption on behalf either the consumer, merchant or both.

Response to Arguments

Applicant argues that the national link of Begum et al is not described as the Internet and there is no motivation to look for alternative solutions. *KSR* forecloses the argument that a specific teaching is required for a finding of obviousness (citing *KSR*, 127 S.Ct. at 1741; 82 USPQ2d at 1396). See Board decision *Ex parte Smith*, -- USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007). The examiner has

laid out reasonable arguments why one of ordinary skill at the time of (applicant's) invention would consider trying the Internet as a predictably successfully alternative. Updating technology as time passes in general is not taken to be non-obvious, especially where success is predictable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc